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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,546	06/14/2000	Dave Robinson	00-0826	7890

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EXAMINER

HAQ, MOHAMMAD AAMIR

ART UNIT PAPER NUMBER

2614

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/593,546	<b>Applicant(s)</b> ROBINSON, DAVE	
	<b>Examiner</b> Aamir Haq	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 25, 26, 30-34, 38-40 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 25, 26, 30-34, 38-40 and 44-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/3/2003 has been entered.

2. This action is in response to applicant's restriction election filed 11/18/2005. Applicant elected to prosecute Species I, claims 25, 26, 30 – 34, 38 – 40 and 44 – 46. Claims 25, 26, 30 – 34, 38 – 40 and 44 – 46 are now pending in the present application.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,501,329 (Provence) in view of US 3,530,261 (Guim).

**As to claims 25 and 26,** Provence teaches a set or cover for attaching to a mouthpiece and earpiece of a telephone handset comprising:

- an earpiece cover comprising:
  - a first base, including a front surface (22 in fig. 5 of Provence) and a rear

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- surface (see fig. 5), with a plurality of holes (26 in fig. 4 of Provence)  
therethrough and further including an outer perimeter;
- said front surface of said first base having an annular lip (22 in fig. 5 of Provence) extending around said outer perimeter of said first base;
- said rear surface of said first base having a perimeter wall (16 in fig. 1 of Provence) extending around said outer perimeter of said first base, said perimeter wall of said rear surface of said first base defining a void adapted for receipt of the earpiece of the telephone handset (see figure 1 of Provence);
- a mouthpiece cover comprising:
  - a second base, including a front surface (22 in fig. 5 of Provence) and a rear surface (see fig. 5), with a plurality of holes (26 in fig. 4 of Provence) therethrough and further including an outer perimeter;
  - said rear surface of said second base having an annular wall (16 in fig. 1 of Provence) extending around said outer perimeter of said second base, said annular wall of said rear surface of said second base defining a void adapted for receipt of the mouthpiece of the telephone handset (see figure 1 of Provence)

Provence does not disclose expressly:

- wherein a diameter of said perimeter wall of said earpiece cover is less than a diameter of said annular wall of said mouthpiece cover such that

said perimeter wall of said earpiece cover is nestable within said annular wall of said mouthpiece cover thereby forming a single compact unit.

However, Guim discloses a configuration for storing a cover of a handset (2 in fig. 3 of Guim) by inserting the cover (2) into a mounting structure (1 in fig. 3 of Guim). The mounting structure (1) has a larger diameter than the cover of the handset (2). Therefore, the configuration enables the cover (2) to be nestable within the wall (4 in fig. 3 of Guim) of the mounting structure (1) thereby forming a single compact unit.

Provence and Guim are analogous art because they are from the same field of endeavor, namely telephone covers. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Provence to fasten the earpiece cover to the mouthpiece cover by inserting one into another instead of using Provence's complex arrangement in view of the teachings of Guim. The motivation for doing so would have been because Provence already contemplated the concept of storing the earpiece and mouthpiece by joining the two covers together, as shown in fig. 2 of Provence. The only difference between the applicant's configuration and the configuration of Provence is merely the method in which the covers are attached to one another. Provence illustrates intricate engaging teeth on each of the covers that connect together. However, Provence discloses expressly, "it is to be realized that the optimum dimensional relationships for the parts of the invention, to include variations in size, materials, shape, form, function and manner of operation, assembly and use, are deemed readily apparent and obvious to one skilled in the art, and all equivalent relationships to those illustrated in the drawings and described in the specification are

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intended to be encompassed by the present invention" (col. 4 lines 58 – 65 of Provence). Therefore, Provence is not limited to a design with the intricate engaging teeth. The combination of Provence with Guim will actually simplify the design, thereby reducing production and manufacturing expenses. This is because it is simpler to design and manufacture covers without intricate engaging teeth. Therefore, one of ordinary skill in the art would be motivated to use this simpler design that achieves the same intended result after viewing the teachings of Provence and Guim. Furthermore, it would have been an obvious substitution of one type of engaging arrangement for another to take advantage of a simpler design in reducing manufacturing costs.

5. Claims 30 and 32 - 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,501,329 (Provence) in view of US 3,530,261 (Guim) further in view of US 5,054,063 (Lo).

**As to claim 30**, Provence and Guim have been discussed above. Provence and Guim do not disclose expressly that the earpiece, mouthpiece or both include a markable surface for a user to record information thereon. However, Lo discloses telephone covers that include markable surface for a user to record information thereon (col. 3 lines 28 – 33 of Lo). More specifically, Lo teaches advertisements may be printed on the covers. This reads on the claimed markable surface for a plurality of reasons. Firstly, the printed advertisement can have a blank area that is markable. If there is not a blank space, the user can still mark over the advertisement to record information. In other words, an advertisement does not preclude a user from marking

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over the advertisement to record information. Lastly, one of ordinary skill in the art would understand that the user could replace an advertisement sticker/printout with a blank sticker/printout for marking. Provence, Guim and Lo are analogous art because they are from the same field of endeavor namely, telephone covers. At the time of the invention it would have been obvious to a person of ordinary skill in the art to have a markable surface on the cover of Provence in view of the teachings of Guim. The motivation for doing so would have been to be able to have an area for text (manufacturer, address, phone number, directions, notes, pin number, etc.) to be input and displayed on the cover. This would enable the user to write down important information and/or advertise/market a product.

**As to claims 32 - 34**, Provence, Guim and Lo have been discussed above. More specifically, see the rationale for the rejections of claims 25 and 30. The rejection of claim 25 addresses attaching the two covers to one another. Claim 30 addresses the writable surface.

6. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,501,329 (Provence) in view of US 3,530,261 (Guim) in view of US 5,054,063 (Lo) further in view of US 6,314,185 (Lashley).

**As to claim 38**, Provence, Guim and Lo have been discussed above. Provence, Guim and Lo do not disclose expressly that that the cover is fabricated of a resilient material.

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However, Lashley discloses a cover for a telephone handset that is fabricated from a resilient material (col. 2 lines 38 – 43 and col. 5 lines 32 – 40 of Lashley). Provence, Guim, Lashley and Lo are analogous art because they are directed to a similar problem solving area, namely covers for telephones. At the time of the invention it would have been obvious to one of ordinary skill in the art to fabricate the cover of Provence out of a resilient material. The motivation for doing so would have been Provence discloses that the invention is “to include variations in size, materials, shape, form,” (col. 4 lines 60 – 61 of Provence). A resilient material would enable the material “to be stretched to fit about the microphone or speaker sections of a telephone handset” and “include memory so as to be able to retain its original shape when removed therefrom” (col. 5 lines 37 – 40 of Lashley). This resiliency would be beneficial when adding and removing the cover from the earpiece or handset. This would enable to cover to have a snug fit and be flexible for various telephones earpieces and mouthpieces that have different size/shape. The resilient material could be “made of any elastomeric material such as latex, rubber, polymeric materials or any combination thereof” (col. 5 lines 35 – 37 of Lashley). In addition, the elastomeric material could also be a soft or firm elastic material. In addition, note that Lo teaches the cover can be fabricated of cotton or cotton fabric (col. 3 line 5 of Lo), which also reads on the claimed resilient material.



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7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,501,329 (Provence) in view of US 3,530,261 (Guim) further in view of US 6,314,185 (Lashley).

**As to claim 31,** Provence and Guim have been discussed above. Provence and Guim do not disclose expressly that the cover is fabricated of a resilient material.

However, Lashley discloses a cover for a telephone handset that is fabricated from a resilient material (col. 2 lines 38 – 43 and col. 5 lines 32 – 40 of Lashley). Provence, Guim and Lashley are analogous art because they are directed to a similar problem solving area, namely covers for telephones. At the time of the invention it would have been obvious to one of ordinary skill in the art to fabricate the cover of Provence out of a resilient material. The motivation for doing so would have been Provence discloses that the invention is “to include variations in size, materials, shape, form,” (col. 4 lines 60 – 61 of Provence). A resilient material would enable the material “to be stretched to fit about the microphone or speaker sections of a telephone handset” and “include memory so as to be able to retain its original shape when removed therefrom” (col. 5 lines 37 – 40 of Lashley). This resiliency would be beneficial when adding and removing the cover from the earpiece or handset. This would enable to cover to have a snug fit and be flexible for various telephones earpieces and mouthpieces that have different size/shape. The resilient material could be “made of any elastomeric material such as latex, rubber, polymeric materials or any combination thereof” (col. 5 lines 35 – 37 of Lashley). In addition, the elastomeric material could also be a soft or firm elastic material.

8. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,501,329 (Provence) in view of US 6,314,185 (Lashley).

**As to claim 39**, Provence has been discussed above. Provence does not disclose expressly that the cover is fabricated of a resilient material.

However, Lashley discloses a cover for a telephone handset that is fabricated from a resilient material (col. 2 lines 38 – 43 and col. 5 lines 32 – 40 of Lashley). Provence and Lashley are analogous art because they are directed to a similar problem solving area, namely covers for telephones. At the time of the invention it would have been obvious to one of ordinary skill in the art to fabricate the cover of Provence out of a resilient material. The motivation for doing so would have been Provence discloses that the invention is “to include variations in size, materials, shape, form,” (col. 4 lines 60 – 61 of Provence). A resilient material would enable the material “to be stretched to fit about the microphone or speaker sections of a telephone handset” and “include memory so as to be able to retain its original shape when removed therefrom” (col. 5 lines 37 – 40 of Lashley). This resiliency would be beneficial when adding and removing the cover from the earpiece or handset. This would enable to cover to have a snug fit and be flexible for various telephones earpieces and mouthpieces that have different size/shape. The resilient material could be “made of any electromeric material such as latex, rubber, polymeric materials or any combination thereof” (col. 5 lines 35 – 37 of Lashley). In addition, the elastomeric material could also be a soft or firm elastic material.

**As to claims 40 and 45**, see the rationale for the rejections of claims 31, 39 and 25.

**As to claim 44**, see the rationale for the rejections of claims 25 and 30 and 31.

**As to claim 46**, see the rationale for the rejection of claims 25, 30 and 31

### ***Response to Arguments***

9. Applicant's arguments filed 11/18/2005 have been fully considered but they are not persuasive. The crux of the applicant's invention is a telephone cover for the earpiece and mouthpiece. Telephone covers are notoriously old and well known in the art, e.g., US 2,593,382 (Zimmerman) "Sanitary Telephone Mouthpiece Attachment" patented April 15, 1952). The applicant's invention is stored by attaching the internal portions (see fig. 4 of applicant's drawings) of the earpiece cover and mouthpiece cover to one another. Thereby making the covers easy to carry together for the user. Provenge contemplated the same idea of storing the telephone covers by attaching the internal portions (see fig. 2 of Provenge) of the earpiece cover and mouthpiece cover to one another. Therefore, the crux of Provenge and the applicant's claimed invention is the same, namely telephone covers that can be stored by attaching the internal side of each cover to one another. The only differentiating factor is the method in which the covers are attached. Provenge teaches a more intricate method which involves teeth or protrusions on each cover joining together. While the applicant claims inserting one cover into another. The configuration of inserting one cover into another is a well known

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configuration for interlocking two objects. As discussed above, Guim teaches this configuration in the field of telephone covers. More general examples are seen in everyday products. For example a pen is generally attached to its cap by inserting the smaller diameter pen into the larger diameter cap. A lid for a coffee cup has a larger diameter to fit around the smaller diameter cup. A top of a medicine bottle has a larger diameter to fit around the smaller diameter bottle. In fact, this method is simpler to manufacture and produce than the more intricate method taught by Provence. In conclusion, the office respectfully views the applicant's invention as not novel over the prior art of Provence in view of the well known method of attaching two elements together by inserting one element with a smaller diameter into an element with a larger diameter as evidenced by Guim.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aamir Haq whose telephone number is 571-272-5511. The examiner can normally be reached on Mon thru Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.H.

A.H.

July 14, 2006

  
WING CHAN  
SUPERVISORY PATENT EXAMINER